



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant[s]: Leslie Graf, *et al.* §
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Attorney Docket No: P12309-US1 §
Customer No.: 27045 §

Group Art Unit: 2154
Examiner: Nabil M. El-Hady
Confirmation No: 4674

For: Addressing in a Communications Network

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Date: May 19, 2005

Name: Jacqueline Wilson

Signature: Jacqueline Wilson

APPEAL UNDER 35 U.S.C. §134

Real Party in Interest

The real party in interest, by assignment, is: Telefonaktiebolaget LM Ericsson (publ)
SE-164 83
Stockholm, Sweden

Related Appeals and Interferences

None.

Status of Claims

Claims 1-6 are pending. Claims 1-2 and 4-6 stand rejected as being unpatentable over Denman *et al.* (US 6,490,451) in view of Reed, *et al.* (US 5,896,440)

Reed); and claim 3 stands rejected as being unpatentable over Denman in view of Reed and further in view of Rose *et al.* (US 6,396,840).

Status of Amendments

No amendments to the claims were made in response to the Final Rejection.

Summary of Invention

The claimed invention relates to a method of signalling in a communications system comprising a Call Control level and a Bearer Control level. The Call Control level includes Media Gateway Controllers and the Bearer Control level includes Media Gateways, each of which is controlled by a Media Gateway Controller. The method includes the steps 1) of allocating to each Media Gateway at least one address, which address corresponds to one of a plurality of different addressing formats, and 2) conveying these addresses between peer Media Gateway Controllers using Bearer Independent Call Control (BICC) or Transport Independent Call Control (TICC) by encapsulating the address using the Network Service Access Point (NSAP) addressing format as defined in ITU-T recommendation X.213.

Issues

- 1.) Whether the finality of the Examiner's Office Action dated July 28, 2004, was premature; and,
- 2.) Whether one or more of the claims, as pending, are patentable over the cited references.

Argument

a.) Finality of Office Action is Improper

In the first office action, dated February 13, 2004, the Examiner rejected claims 1, 2 and 4-6 as being **anticipated** by United States Patent No. 6,490,451 issued to Denman, *et al.* In response to that Office Action, the Applicants filed a response, including minor amendments to the claims and traversing the rejection. The Examiner then, in a Final Office Action dated July 28, 2004, rejected those claims as being

obvious in view of Denman and Reed. In response to the Final Office Action, the Applicants traversed the propriety of the finality of the office action. The Examiner, although not stating so in the Final Office Action, stated in an Advisory Action dated April 28, 2005, that the finality of the office action was "proper and necessitated by applicant [*sic*] substantive claim amendments [*sic*]." It is improper for the Examiner to reject Applicant's arguments traversing a §102 rejection by asserting a new reference (Reed), because the Examiner is asserting a new ground of rejection which was not necessitated by substantive claim amendments. See: MPEP §107.07(a).

The claim amendments made in response to the Office Action dated February 13, 2004, included the addition to claims 1 and 5 that the conveying of messages between peer Media Gateway Controllers was performed "using Bearer Independent Call Control (BICC) or Transport Independent Call Control (TICC)." Specifying that messages between peer Media Gateway Controllers using BICC does not constitute new matter, nor is it a substantive claim amendment that would necessitate a new search by the Examiner, because that aspect of the invention was included in claim 6 as originally filed. Furthermore, the Transport Independent Call Control (TICC) limitation, also added to claims 1 and 5, is analogous to BICC and is expressly described in the specification; thus, it also does not constitute new matter nor would it necessitate a new search by the Examiner. Finally, The claim amendments included the addition to claims 1, 5 and 6 that the Network Service Access Point (NASP) addressing format is the format defined in ITU-T recommendation X.213. Whereas it is expressly stated in the specification that the NASP addressing format is the format defined in ITU-T recommendation X.213, this amendment also does not constitute new matter nor would it necessitate a new search by the Examiner.

If the Examiner desires to reject Applicants' claims, and arguments, based on a combination of references, he should withdraw the finality of the Office Action and issue a new Office Action clearly supporting his rejection based on such combination of references. Accordingly, the Applicants traverse the finality of the present Office Action.

b.) Examiner's Finding of Obviousness is Conclusory

The Examiner asserts that Denman discloses "conveying . . . addresses between peer media gateway controllers using bearer independent call control (BICC) or transport independent call control (TICC) by encapsulating [the] address using the network service point (NSAP) addressing format." A search of Denman, however, fails to disclose any discussion of the use of BICC, TICC or NSAP, in any form, much less the manner as recited in claim 1. Therefore, the Examiner's reliance on Denman as a primary reference in the rejection of claim 1 is unsupportable.

The Examiner does recognize, however, that Denman fails to disclose the use of the addressing format as defined in ITU-T recommendation X.213. To overcome the deficiencies of Denman, the Examiner has looked to the teachings of Reed, which the Examiner states "shows the addressing format as defined in ITU-T recommendation X.213." The Examiner then concludes that it would have been obvious to combine Denman with Reed, stating that "[t]he motivation would have been to have an open SS7 addressing scheme." The Examiner, however, does not point to any teaching or suggestion in Denman or Reed of such a motivation. Even if there were such a motivation in the prior art, it is conceivable there could be many solutions that would provide an "open SS7 addressing scheme." It is only the Applicants' claimed solution that is relevant to the obviousness inquiry, and the Examiner has pointed to no teachings in the prior art that would motivate one to arrive at the invention of claim 1. As stated in MPEP §706.02(j):

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention **or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.**" *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

* * *

It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply. (emphasis added)


Whereas the Examiner has not provided any reasoning as to why one of ordinary skill in the art would have found the claimed invention obvious, the Examiner has failed to establish a *prima facie* case of obviousness.

Whereas independent claims 5 and 6 recite limitations analogous to those of claim 1, those claims are also not obvious over Denman in view of Reed. Furthermore, whereas claims 2-4 are dependent from claim 1, and include the limitations thereof, those claims are also not obvious.

CONCLUSION

in view of the foregoing remarks, the Applicants request that the Examiner's rejection of the claims be reversed and the application be remanded for further prosecution.

Respectfully submitted,


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APPENDIX
Pending Claims

1. (Previously Presented) A method of signalling in a communications system comprising a Call Control level and a Bearer Control level, where the Call Control level comprises a plurality of Media Gateway Controllers and the Bearer Control level comprises a plurality of Media Gateways each of which is controlled by a Media Gateway Controller, the method comprising allocating to each Media Gateway at least one address, which address corresponds to one of a plurality of different addressing formats, and conveying these addresses between peer Media Gateway Controllers using Bearer Independent Call Control (BICC) or Transport Independent Call Control (TICC) by encapsulating said address using the Network Service Access Point (NSAP) addressing format as defined in ITU-T recommendation X.213.

2. (Original) A method according to claim 1, wherein the communications network is a telecommunications network in which the Call Control level is used to establish and control call connections between a calling party and a called party at the Bearer Control level.

3. (Previously Presented) A method according to claim 1, wherein the Media Gateways provide access to transport networks which extend between peer Media Gateways, and the networks use one of IP, AAL2, or ATM transmission mechanisms.

4. (Original) A method according to claim 1, wherein the format of the at least one address allocated to a Media Gateway is the format used by a transport network to which that Media Gateway provides access.

5. (Previously Presented) A communications system comprising;
a Call Control level comprising a plurality of Media Gateway Controllers; and

a Bearer Control level comprising a plurality of Media Gateways each of which is controlled by a Media Gateway Controller and each of which is allocated at least one address which address corresponds to one of a plurality of different addressing formats, wherein said peer Media Gateway Controllers communicate Media Gateway addresses using Bearer Independent Call Control (BICC) or Transport Independent Call Control (TICC) by encapsulating said addresses using the Network Service Access Point (NSAP) addressing format as defined in ITU-T recommendation X.213.

6. (Previously Presented) A Media Gateway Controller of a communications system, the Media Gateway Controller comprising:

means for communicating with at least one Media Gateway for the purpose of establishing and controlling call connections over a transport network to which the Media Gateway is coupled, the Media Gateway being allocated at least one address which address corresponds to one of a plurality of different addressing formats; and

means for communicating with at least one peer Media Gateway Controller using a Bearer Independent Call Control (BICC) protocol, a BICC protocol conveying Media Gateway addresses by encapsulating said addresses using the Network Service Access Point (NSAP) addressing format as defined in ITU-T recommendation X.213.
